

Application No. 09/766,539

Atty Docket: BLFR 1005-1

REMARKS

Claims 1-119 are currently pending in this application. In response to the restriction requirement mailed 31 October 2005, Applicant has provisionally elected **Group I**, with traversal and a proposal for representative examination.

For reference, as presented by the Examiner, the groups are: **Group I** (claims 1-23 and 116, directed to an improved decision support system that includes one or more additional analysis programs that generate at least two analyses); **Group II** (claims 24-46, directed to an improved decision support system that utilizes an analysis program to generate data reported in an open to buy report); **Group III** (claims 47-69, directed to an improved decision support system that utilizes an analysis program to generate the data of a markdown management report); **Group IV** (claims 70-92, directed to an improved decision support system that utilizes an analysis program to generate the data reported in bottom-up planning reports); **Group V** (claims 93-115, directed to an improved decision support system that utilizes an analysis program to generate promotional forward buying reports); and **Group VI** (claims 117-119, directed to a calendar component that has a schedule of display fixtures at selling locations for goods).

Limits on Discretion to Restrict

The new revision of the MPEP, published August 2005, is much clearer on the limits on an Examiner's discretion to impose restriction requirements than the prior MPEP. In particular, § 803 *et seq.* set standards that the Examiner may not be aware of, as she has not referenced them.

802.01 Meaning of "Independent" and "Distinct" [R-3]**II. < DISTINCT**

**>Two or more inventions are related (i.e., not independent) if they are disclosed as connected in at least one of design (e.g., structure or method of manufacture), operation (e.g., function or method of use), or effect.

Examples of related inventions include< combination and part (subcombination) thereof, process and apparatus for its practice, process and product made, etc. **>In< this definition the term related is used as an alternative for dependent in referring to *>inventions< other than independent *>inventions<.

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>Related inventions are distinct if the inventions as claimed are not connected in at least one of design, operation, or effect (e.g., can be made by, or used in, a materially different process) and wherein at **least one invention is PATENTABLE** (novel and nonobvious) **OVER THE OTHER** (though they may each be unpatentable over the prior art). See MPEP § 806.05(c) (**combination and subcombination**) and § 806.05(j) (**related products or related processes**) for examples of when a **two-way test is required for distinctness**.<

803 Restriction — When Proper [R-3]

Under the statute>, the claims of< an application may properly be required to be restricted to one of two or more claimed inventions only if they are able to support separate patents and they are either independent (MPEP § **>802.01, § 806.06, and § 808.01<) or distinct (MPEP § 806.05 - § *>806.05(j)<). If the search and examination of **>all the claims in an< application can be made **without serious burden**, the examiner **must** examine *>them< on the merits, even though **>they include< claims to independent or distinct inventions. >

I. < CRITERIA FOR RESTRICTION BETWEEN PATENTABLY DISTINCT INVENTIONS

There are two criteria for a proper requirement for restriction between patentably distinct inventions:

- (A) The inventions must be independent (see MPEP § 802.01, § *>806.06<, § 808.01) or distinct as claimed (see MPEP § 806.05 - § *>806.05(j)<); and
- (B) There *>would< be a **serious burden** on the examiner if restriction is >not< required (see MPEP § 803.02, **>§ 808<, and § 808.02).

For purposes of the initial requirement, a **serious burden** on the examiner may be *prima facie* shown ** by appropriate explanation of separate classification, or separate status in the art, or a different field of search as defined in MPEP § 808.02. That *prima facie* showing may be **rebutted by appropriate showings** or evidence by the applicant. Insofar as the criteria for restriction practice relating to Markush-type claims is concerned, the criteria is set forth in MPEP § 803.02. Insofar as the criteria for restriction or election practice relating to claims to genus-species, see MPEP § *>806.04< - § 806.04(i) and § 808.01(a).

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806.05(c) Criteria of Distinctness *> Between< Combination *>and< Subcombination ** [R-3]

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To support a requirement for restriction >between combination and subcombination inventions<, both two-way distinctness and reasons for insisting on restriction are necessary, i.e., >there would be a serious search burden as evidenced by< separate classification, status, or field of search. See MPEP § 808.02.

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I. SUBCOMBINATION ESSENTIAL TO COMBINATION***AB_{sp}/B_{sp} No Restriction***

Where a combination as claimed sets forth the details of the subcombination as separately claimed, there is no evidence that combination AB_{sp} is patentable without the details of B_{sp}. The inventions are not distinct and a requirement for restriction must not be made or maintained, even if the subcombination has separate utility. This situation can be diagrammed as combination AB_{sp} ("sp" is an abbreviation for "specific"), and subcombination B_{sp}. Thus the specific characteristics required by the subcombination claim B_{sp} are also required by the combination claim.

(the "****" notations are from the MPEP text; the " * * " notations are added to indicate omitted sections). The final section, "subcombination essential to combination" is added in this revision and of particular interest in this response.

Proposal for Representative Examination

Applicants propose initial representative examination of the six independent claims plus claims 2-18, 116 and 118-19, for a total of 26 out 119 claims. Five of the six independent claims are a linked group, claim 1 being the linking claim. Claims 117-119 present a display fixture issue that overlaps with application no. 09/755,635, "Method And Apparatus For Modification Of Basic Good Forecasts", which the same Examiner is concurrently examining.

The idea for representative examination comes from remarks to the AIPLA by Commissioner John Doll. In many cases filed a few years ago, before repricing of claims examination, it is practical to look at the structure of the independent and dependent claims and pick representative claims to examine. In claims 1-115 of this

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case, dependent claims are repeated under each independent claim. Four of the five independent claims are subcombinations of claim 1. Applicants can reasonably select 17 of the 22 dependent claims in each set as representing all 22. Representative examination of 18 out of 115 claims will cover all significant issues, without restriction requirements, petitions and the like.

Representative examination is an initial step. If the representative claims are allowed, the remaining claims all need to be examined prior to allowance. However, the remaining claims will not present any new or different issues and should be examined with ease and great dispatch.

As a practical matter, this structure of representative examination would play well with the status of claim 1 as a linking claim. There is no current reason to believe that claim 1 will not be allowed. The cited Landvater reference has been successfully distinguished – the Examiner has not disagreed with Applicants' position – and a new element has been added to further distinguish over Landvater. The Examiner came across Landvater in a second search, after the TSI reference was shown lacking. Even if a restriction requirement is maintained and upheld, allowance of claim 1 would automatically lead to reinstatement of claims 24-115. Only claim 116-119 are on different footing.

Applicants are not sure who would have to agree to proceed by representative examination, but it's good for the Examiner, good for the Applicant and suggested by the Commissioner.

The Examiner's Rationale does not Satisfy the Current MPEP, version 8 revision 3

The new MPEP revision clearly requires two way distinctness for restriction of subcombinations. MPEP § 806.05(c) (reproduced above). Separate utility is no longer enough.

The Examiner has not made a *prima facie* case of two way distinctness, as measured by the new MPEP guidance. Therefore the restriction is improper.

The new MPEP further emphasizes that the Examiner must prove that a serious burden would result if restriction were not required. §§ 803, 806.05(c).

The examiner's burden argument never uses the phrase "serious burden" and makes some statements that are mistaken. Without giving reasoning and examples as to the burden involved and without even arguing a "serious burden", the Examiner

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cannot make out a *prima facie* case. The key mistaken statement is that the search required for Group I is not specifically required for all of groups II-V. It appears to us that the technical element covered in claim 1 and therefore searched, cover all of the technical elements found in the independent claims that lead groups II-V. The Examiner has not pointed to any technical elements in Groups II-V that are not also in Group I and has, in fact, assigned all four groups to the same class and subclass for searching. Since the search required from Group I includes all of the technical elements found in groups II-V, restriction among groups I-V is improper.

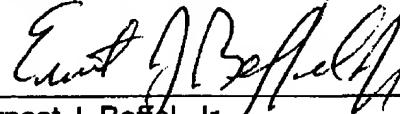
It is too late to claim serious burden of searching groups I-V together. We have successfully traversed two entirely distinct sets of rejections based on TSI and Landvater. All of Groups I-V are assigned to a class and subclass that already has been searched twice. The Examiner should not be conducting additional searches merely in the hope of finding additional art. C.f., MPEP §§ 704.01 & 706.05 (should give full faith and credit to search by other examiner, unless clear error in prior search). As the searching has been done already, there cannot be any serious burden due to a minor supplemental search of these groups together.

CONCLUSION

Applicant respectfully submits that the pending claims are now in condition for allowance and thereby solicits acceptance of the claims, in light of these amendments.

The undersigned can ordinarily be reached at his office at (650) 712-0340 from 8:30 a.m. to 5:30 p.m. PST, Monday through Friday, and can be reached at his cell phone at (415) 902-6112 most other times.

Respectfully submitted,



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Dated: 30 November 2005

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